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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,033	07/26/2007	Maurizio Marini	6254.730	5813
44362	7590	12/02/2009		
Pequignot + Myers LLC 140 Marine View Avenue Suite 220 Solana Beach, CA 92075			EXAMINER ARNETT, NICOLAS ALLEN	
			ART UNIT 3751	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/591,033	MARINI, MAURIZIO
	<b>Examiner</b>	<b>Art Unit</b>
	NICOLAS A. ARNETT	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 August 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 25 August 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>01/27/2009</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 66.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 86.
3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the use of legal phraseology. Correction is required. See MPEP § 608.01(b).

#### ***Claim Objections***

6. Claims 2 and 5 are objected to because of the following informalities: "fluidtight" should be - - fluid-tight - -. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Regarding claim 1, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the

claimed invention. See MPEP § 2173.05(d). Claims 2-14 are rejected based on their dependence from claim 1.

b. In claims 2 and 13, "said connecting means" renders the claims indefinite because claim 1 recites 2 different "connecting means for connecting."

Therefore, it is unclear which "connecting means" is being referred to in the dependent claims. The examiner suggests changing the second "connecting means for connecting" in claim 1 to - - container connecting means for connecting - - and the dependent claims changed to refer to the "connecting means" or "container connecting means" as appropriate.

c. In claim 5, it is unclear if the "dispenser unit (40)" is the same element as the "connecting means for stably connecting said container" of claim 1 or a separate, discrete element. From the disclosure it appears that both are the same element.

d. Claim 5 recites the limitation "said valve device" in line 3. There is insufficient antecedent basis for this limitation in the claim. For proper antecedent basis within the claims, it appears claim 5 should depend from claim 2 rather than claim 1.

e. Claim 11 recites the limitation "said three-way valve" in line 1. There is insufficient antecedent basis for this limitation in the claim. For proper antecedent basis within the claims, it appears claim 11 should depend from claim 10 rather than claim 9.

f. Claim 12 recites the limitation "said additional hose" in line 2. There is insufficient antecedent basis for this limitation in the claim. For proper antecedent basis within the claims, it appears claim 12 should depend from claim 10 rather than claim 1.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 5-6, 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication 2003/0056851 to Eriksen et al. (Eriksen).

Regarding claim 1, Eriksen discloses a kit (1) for inflating and repairing inflatable articles, the kit comprising a compressor assembly (2), a container (3) of sealing liquid, and connecting means (hoses 6 and 10) for connecting the container to the compressor assembly and to an inflatable article for repair or inflation, and being characterized by comprising an outer casing (housings 31 and 32) housing said compressor assembly (Figs. 5 and 7) and defining a seat (Figs. 7 and 10-12) for the container of sealing liquid, said container being housed removably in said seat ([0092] and [0105]), and by comprising connecting means (41) for stably connecting said container to said

compressor assembly (Figs. 7 and 10-12), so that the container, when housed in said seat, is maintained functionally connected to said compressor assembly.

Regarding claim 2, Eriksen discloses said connecting means comprise a compressed-air feed line (6) for feeding compressed air from said compressor assembly to said container; said container comprising a vessel having an opening (opening defined by neck 37), and a valve device (seal 38, piece 45 and plunger 46 define the valve device) fitted in fluid-tight manner to the opening (when the bottle is attached to the cylinder 41, the valve device is fitted to the opening) and having an inlet (29) connectable to said compressed-air feed line, and an outlet (30) for the sealing liquid.

Regarding claim 3, Eriksen discloses said valve device comprises at least one control member (46) movable, in response to pressurization of said compressed-air feed line, from a closed position (shown in Fig. 10), closing said valve device and in which said inlet and said outlet are isolated from the inside of said container, to an open position (shown in Figs. 11 and 12) in which said inlet and said outlet communicate with the inside of said container.

Regarding claim 5, Eriksen discloses the container connecting means comprises a dispenser unit (41) detachably connectable to said container and having an inlet fitting (lower chamber 44) connected in fluid-tight manner to said inlet of said valve device (Figs. 10-12), and an outlet fitting (upper chamber 43) connected in fluid-tight manner to said outlet of said valve device (Figs. 10-12).

Regarding claim 6, Eriksen discloses said dispenser unit is detachable from said casing ([0105]).

Regarding claim 9, Eriksen discloses said dispenser unit comprises a cavity (threaded portion 40) to which is fitted a neck (37) of said container in an upside down position (Figs. 7 and 10-12), said neck defining said opening (Figs. 7 and 10-12).

Regarding claim 13, Eriksen discloses said connecting means comprise a non-return valve (61).

11. Claims 1, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WIPO Publication WO 03/004328 to Laetgaard (Laetgaard).

Regarding claim 1, Laetgaard discloses a kit (abstract) for inflating and repairing inflatable articles, the kit comprising a compressor assembly (8), a container (4) of sealing liquid, and connecting means (sleeve 15, piece 16 and tube 12) for connecting the container to the compressor assembly and to an inflatable article for repair or inflation, and being characterized by comprising an outer casing (box 1) housing said compressor assembly (Fig. 2) and defining a seat (Figs. 1-4) for the container of sealing liquid, said container being housed removably in said seat (page 4, lines 23-25) and by comprising connecting means (18, 19) for stably connecting said container to said compressor assembly (Figs. 1-4), so that the container, when housed in said seat, is maintained functionally connected to said compressor assembly.

Regarding claim 12, Laetgaard discloses said connecting means is connected to a relief valve (14).

Regarding claim 13, Laetgaard discloses said connecting means comprise a non-return valve (27).

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,283,172 to Thurner (Thurner).

Regarding claim 1, Thurner discloses a kit (abstract) for inflating and repairing inflatable articles, the kit comprising a compressor assembly (28), a container (56) of sealing liquid, and connecting means (tubes 16 and 30) for connecting the container to the compressor assembly and to an inflatable article for repair or inflation, and being characterized by comprising an outer casing (box 22) housing said compressor assembly (Figs. 1-3) and defining a seat (Figs. 1-3) for the container of sealing liquid, said container being housed removably in said seat (col. 3, line 61 – col. 4, line 3) and by comprising connecting means (40) for stably connecting said container to said compressor assembly (Figs. 1-3), so that the container, when housed in said seat, is maintained functionally connected to said compressor assembly.

#### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 4, 7, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eriksen.

Regarding claim 4, Eriksen does not disclose said valve device comprises elastic means for keeping said control member stably in said closed position in the absence of pressure to said inlet. However, the examiner takes official notice that elastic means are well known in the art for biasing a valve to a closed position. Therefore, it would have been obvious to one of ordinary skill at the time of invention to have included elastic means in the valve device of Eriksen to bias the plunger to a closed position to prevent inadvertent breaking of the seal on the container.

Regarding claims 7, 8 and 14 Eriksen discloses said seat comprises a base portion (see Figs. 7 and 10-12), but does not discloses the base having fast-fit fastening means by which to secure said dispenser unit to said casing, said fastening means comprising a bayonet connection or a fast-fit click-on coupling. Eriksen discloses the dispenser unit is connected by a screw on a side wall. However, the examiner takes official notice that bayonet connections and click-on couplings are well known in the art as an alternative to the use of screws for connecting removable parts. Therefore, it would have been obvious to one or ordinary skill in the art at the time of invention to have replaced the screw of Eriksen with a bayonet or click-on coupling for securing the dispenser unit to the casing. Further, the location of the fastening means is a matter of design choice and connecting to a base portion rather than a side wall would be obvious based on the shape and orientation of the parts being connected.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-9 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-12 of copending Application No. 10/591032. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of application 10/591032 disclose a kit for inflating a repairing inflatable articles comprising a compressor, a container of sealant, means for connecting the container to the compressor and inflatable article, an outer casing defining a seat and container connecting means for stably connecting the container to the compressor assembly. Further, claims 7-12 of application 10/591032 disclose a valve device having an inlet, outlet and movable member, a dispenser unit and fast-fitting fastening means for securing the dispenser unit to the casing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

17. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose nor render obvious a kit for repairing inflatable articles comprising, in combination with the claimed invention as a whole, an additional hose cooperating with said inflatable article and a three-way valve having an input connected to said compressor assembly and an output connected to said container and to said additional hose to direct a stream of compressed air selectively to said container or to said additional hose.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,789,581 discloses a tire repair kit including a compressor having a casing which defines a seat for a removable container of sealing fluid and further includes a removable dispenser unit having inlet and outlet fittings. US Patent 7,028,720, US Patent 7,021,348, US Patent 6,968,869, US Patent 6,889,723, US Patent 6,766,834, US Patent 6,736,170, US Patent 6,412,524, US Patent

6,345,650, US Patent 6,176,285, US Patent 5,070,917, US Patent 4,765,367, US Patent 5,403,417, and US Patent 5,908,145 each disclose kits for repairing inflatable articles generally related to Applicant's disclosure and claimed invention.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLAS A. ARNETT whose telephone number is (571)270-5062. The examiner can normally be reached on Monday - Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAA

/Gregory L. Huson/  
Supervisory Patent Examiner, Art Unit 3751